

REMARKS

Applicant: Gary C. Johnson

Art Unit : 3681

Examiner / Supervisor: Charles (chuck) Marmor

Concerning Replacement Drawing #2

The new Director; John Love of; Patent Technology Center 3600, refused to enter the replacement drawing #2, stating; new matter. However, as you know; the concept of new matter applies toward amendments attempting to add new disclosure to the description or drawings for the purpose of directing a claim to said new disclosure. MPEP 706.03(o) states;

"In amended cases, subject matter not disclosed in the original application is sometimes added and a claim directed thereto. Such a claim is rejected on the ground that it recites elements without support in the original disclosure under 35 U.S.C. 112, first paragraph,"

See also; MPEP 2164.08(c)

2164.08(c) Critical Feature Not Claimed A feature which is taught as critical in a specification and is not recited in the claims should result in a rejection of such claim under the enablement provision section of 35 U.S.C. 112.

Limiting an applicant to the preferred materials in the absence of limiting prior art would not serve the constitutional purpose of promoting the progress in the useful arts. Therefore, an enablement rejection based on the grounds that a disclosed **critical limitation is missing from a claim should be made only when the language of the specification makes it clear that the limitation is critical for the invention to function as intended.**

Notice that no 35 U.S.C. 112 enablement rejection was made concerning the alleged new matter to the replacement drawing, neither indeed can be. Using the Director's own form of reasoning, I just established that the alleged new matter is not a critical feature even to those who would not otherwise know what "bosses / boss" are. A boss is the common support stock around the axis of a rotatable housing of any machine, in any art / field.

It was an oversight that it was not included in ~~the~~ my non-provisional drawing. Notice in my "original disclosure" drawing of; my provisional application.

"Limiting an applicant to the preferred materials in the absence of limiting prior art would not serve the constitutional purpose of promoting the progress in the useful arts" – MPEP 2164.08 (c).

Notice that, there isn't / hasn't been applied any prior art against my patent application since the 2nd office action of; May 3, 2003.

See also:

706.03 Rejections Not Based on Prior Art

The primary object of the examination of an application is to determine whether or not the claims are patentable over the prior art. This consideration should not be relegated to a secondary position while undue emphasis is given to nonprior art or "technical" rejections. Effort in examining should be concentrated on truly essential matters, minimizing or eliminating effort on technical rejections which are not really critical. Where a major technical rejection is proper (e.g., lack of proper disclosure, undue breadth, utility, etc.) such rejection should be stated with a full development of the reasons rather than by a mere conclusion coupled with some stereotyped expression.

2141.03 Level of Ordinary Skill in the Art [R-2]

FACTORS TO CONSIDER IN DETERMINING LEVEL OF ORDINARY SKILL

The "hypothetical 'person having ordinary skill in the art' to which the claimed subject matter pertains would, of necessity have the capability of understanding the scientific and engineering principles applicable to the pertinent art."

608.02(f) Modifications in Drawings [R-3]

All modifications described must be illustrated, or the text canceled. (*Ex parte Peck*, 1901 C.D. 136, 96 O.G. 2409 (Comm'r Pat. 1901).) **This requirement does not apply to a mere reference to minor variations nor to well-known and conventional parts.**

2164.08 Enablement Commensurate in Scope With the Claims [R-2]

The examiner should determine what each claim recites and what the subject matter is when the claim is considered as a whole, not when its parts are analyzed individually. No claim should be overlooked. With respect to dependent claims, 35 U.S.C. 112, fourth paragraph, should be followed. This paragraph states that "a claim in a dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers" and requires the dependent claim to further limit the subject matter claimed.

The Federal Circuit has repeatedly held that "the specification must teach those skilled in the art how to make and use the full scope of the claimed invention without 'undue experimentation'." *In re Wright*, 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993). **Nevertheless, not everything necessary to practice the invention need be disclosed. In fact, what is well-known is best omitted.**

2165.01 Considerations Relevant to Best Mode [R-2]

I. DETERMINE WHAT IS THE INVENTION

Determine what the invention is - the invention is defined in the claims. **The specification need not set forth details not relating to the essence of the invention.**

903.02(b) Scope of a Class

Basic Subject Matter Combined with Perfecting Feature. Features may be added to the basic subject matter which do not change the character thereof, but do perfect it for its intended purpose; e.g., an overload release means tends to perfect a stonecrusher by providing means to stop it on overload and thus prevent ruining the machine. **However, this perfecting combined feature adds nothing to the basic character of the machine.**

35 U.S.C. 112, sixth paragraph

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

This is how futile the assertion of new matter is; all I have to do to overcome the attack against my drawing is; include it as a means. The examiner already provided the support structure, see; office action of; 12/06/05, page 11; line # 1.

I know the reason and the consequence of the act of not allowing this drawing modification and if I had not challenged it. It allows for an improved version of my invention, even if a term patent is still in effect (derivation is not possible in this case because of my provisional application filing date).

By the way, the examiner though, faulty; drafted an "Suggested Allowable Claim" which covers every element of my invention. This is another careless action on the part of the examiner. This proves patentability; perfectly and indisputably.

2121.04 Apparatus and Articles - What Constitutes Enabling Prior Art

PICTURES MAY CONSTITUTE AN "ENABLING DISCLOSURE"

Pictures and drawings may be sufficiently enabling to put the public in the possession of the article pictured. Therefore, such an enabling picture may be used to reject claims to the article. **However, the picture must show all the claimed structural features and how they are put together.** *Jockmus v. Leviton*, 28 F.2d 812 (2d Cir. 1928). See also MPEP § 2125 for a discussion of drawings as prior art.

My patent application drawing shows all of it's claimed structure features and how they are put together. Patentability over prior art is based on structure. The examiner continues to assert that he can't determine patentability; based on the claims, even though he drafted an allowable claim (only one is needed, if it covers the whole invention).

2114 - APPARATUS CLAIMS MUST BE STRUCTUR-ALLY DISTINGUISHABLE FROM THE PRIOR ART

CONCERNING THE FINAL ACTION

2111 Claim Interpretation; Broadest Reasonable Interpretation [R-1]

CLAIMS MUST BE GIVEN THEIR BROADEST REASONABLE INTERPRETATION

During patent examination, the pending claims must be "given *>their< broadest reasonable interpretation consistent with the specification." >*In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).< Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified.

2143.03 - INDEFINITE LIMITATIONS MUST BE CON-SIDERED A claim limitation which is considered indefinite cannot be disregarded. If a claim is subject to more than one interpretation, at least one of which would render the claim unpatentable over the prior art, the examiner should reject the claim as indefinite under 35 U.S.C. 112, second paragraph (see MPEP § 706.03(d)) and should reject the claim over the prior art based on the interpretation of the claim that renders the prior art applicable.

An application can not be passed to final action where there is no prior art rejections, particularly when the examiner failed to evaluate the claims because of alleged indefiniteness. The examiner did this in office actions # 's 4, 5, 6.

Furthermore, I know that the examiner completely ignored the advantages, disregarded all procedure such as; pointing out errors, drafting first claim from the start, distilled the invention instead of considering the whole application, not pointing out insufficient disclosure, and too many other errors to include at this time. It will be in the book.

(5)

~~Boase C. Johnson~~
Gary C. Johnson
611 Chene
Detroit, MI 48207

10/31/06



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GARY C. JOHNSON
2064 Lafayette
Detroit, MI 48207

In re Application of
Gary Carlton Johnson
Serial No: 10/021,656
Filed: December 12, 2001
For: JOHNSON-POSTIVE ACTION CONTINUOUS
TRACTION (P.A.C.T.)
VEHICLE DIFFERENTIAL

: DECISION ON PETITION
: TO WITHDRAW THE
: FINALITY OF OFFICE
: ACTION

This is a decision on the petition under 37 CFR 1.181 filed May 22, 2006 to revoke the final action mailed December 6, 2005 and the Advisory Action mailed March 22, 2006, and enter the amendment filed March 2, 2006.

The petition is **Granted-In-Part**.

A review of the application file history reveals that applicant filed an amendment May 23, 2005 in response to a Notice of Noncompliant Amendment mailed May 4, 2005. An Office action was mailed June 28, 2005 in which the examiner objected under 35 USC 132 to the amendment of May 23, 2005 as containing new matter and rejected the claims under 35 USC 112 second paragraph. Applicant filed an amendment July 21, 2005 amending the claims and providing arguments. A Notice of Non-Compliant Amendment was mailed August 4, 2005 and in response applicant filed an amendment August 15, 2005. An Office action was mailed October 24, 2005 in which the examiner again objected under 35 USC 132 to the amendment filed May 23, 2005 as containing new matter, objected to the specification under 37 CFR 1.75(d)(1) as failing to provide proper antecedent basis for claimed subject matter and rejected claims 15 and 16 under 35 USC 112 first paragraph. Applicant filed a response November 17, 2005 providing arguments concerning the October 24, 2005 Office action. On December 6, 2005 a final rejection Office action was mailed in which the examiner again objected under 35 USC 132 to the amendment filed May 23, 2005 as containing new matter, again objected to the specification under 37 CFR 1.75(d)(1) as failing to provide proper antecedent basis for claimed subject matter again rejected claims 15 and 16 under 35 USC 112 first paragraph and suggested an allowable claim for applicant to file. Applicant filed an amendment March 2, 2006. An Advisory Action was mailed March 22, 2006 refusing entry of the March 2, 2006 amendment because it raised new issues that would require further consideration and/or search, raised the issue of new matter and did not place the application in better form for appeal.



Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97 (c) with the fee set forth in 37 CFR 1.17(p). See MPEP 706.07(a). A review of the Office action of October 24, 2005 and the final rejection of December 6, 2005 shows that the examiner did not introduce a new ground of rejection in the final rejection. The rejections were the same as those set forth in the October 24, 2005 Office action. Therefore, making the December 6, 2005 Office action final was proper.

The examiner refused entry of the March 2, 2006 amendment after final because it raised new issues that would require further consideration and/or search, raised the issue of new matter and did not place the application in better form for appeal. The drawings filed March 2, 2006 still have the added support stock protruding from axial sides of the differential case that was objected to in the December 6, 2005 final rejection as new matter and still should not be entered. The amended sections of the specification that were submitted March 2, 2006 remove the new matter that the examiner objected to in those sections. Furthermore, applicant submitted a statement that the sections of the specification he was amending contained no new matter. MPEP 714.13 states "However, if the proposed amendment raises the issue of new matter, the examiner should identify the subject matter that would constitute new matter." The examiner did not identify in the March 22, 2006 Advisory Action what constituted new matter in the proposed amendments to the specification and applicant stated it contained no new matter. Therefore the proposed amendments to the specification should have been entered. The March 2, 2006 amendment canceled all previous claims and added two new claims 17 and 18. A review of claims 17 and 18 shows that they do not include the features pointed out as lacking support in the original application in the 35 USC 112 first paragraph rejection of the December 6, 2005 final rejection. MPEP 714.13 states "If the proposed amendment presents new issues requiring further consideration and/or search, the examiner should provide an explanation as to the reasons why the proposed amendment raises new issues that would require further consideration and/or search." The examiner stated in the March 22, 2006 Advisory Action that new claims 17 and 18 would require further consideration and search but did not provide an explanation as to the reasons. Since both the amendments to the specification and the new claims appear to eliminate the specific objections the examiner had with the specification and the previous claims and because the examiner provided no explanation of what the new matter issues are or why the amendment would require further consideration and search, the amendments to both the specification and claims appear to possibly avoid the objections and rejections set forth in the December 6, 2006 final rejection and place the case in better condition for appeal or allowance. Therefore the March 2, 2006 amendments to the specification and claims should have been entered.

The application will be promptly returned to the examiner for consideration of the amendment of March 2, 2006.

Telephone inquiries relative to this decision should be directed to Supervisory Patent Examiner Charles Marmor at (571) 272-7095.

SUMMARY: The petition is **GRANTED-IN-PART**. The December 6, 2006 final rejection will not be revoked. The replacement drawing of March 2, 2006 will not be entered. The amendments to the specification and claims filed March 2, 2006 will be entered.


John Love, Director
Patent Technology Center 3600
(571) 272-5250

pp:cm:9/29/06